



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/598,108

08/17/2006

Seiki Tamura

P-671PCT

1093

27305

7590

06/17/2010

HOWARD & HOWARD ATTORNEYS PLLC
450 West Fourth Street
Royal Oak, MI 48067

EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

06/17/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/598,108	Applicant(s) TAMURA ET AL.	
	Examiner Margaret G. Moore	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 16 is/are pending in the application.
- 4a) Of the above claim(s) 6, 14 to 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 5, 7 to 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/23/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1796

1. Applicant's election of Group I in the reply filed on 4/20/2010 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Please note that as a result of this election the application has been transferred. It is currently being examined by Margaret Moore.

3. Applicant is advised that should claims 3, 4 and 12 be found allowable, claims 7, 10 and 13 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The Examiner cannot find a difference between these two sets of claims.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 to 5 and 7 to 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2003-048813 (cited in applicants' IDS) in view of JP 2003-306550 (as interpreted by the English language translation provided).

JP 2003-048813 teaches a cosmetic composition for hair containing an alkyl modified polydimethylsiloxane. See the abstract. This also teaches a water in oil emulsion containing the alkyl modified polydimethylsiloxane. The alkyl group can have from 4 to 30 carbon atoms, which includes the entire claimed range of from 4 to 18 carbon atoms. The siloxane is a trisiloxane, meeting the

Art Unit: 1796

structure in claim 2. This reference teaches the General Formula (1) in claim 1 but does not specify how it is prepared.

JP 2003-306550 teaches a method of making and, specifically, deodorizing an alkyl modified polydimethylsiloxane. As can be seen from paragraph 3, such alkyl modified siloxanes are prepared by a method in which an alpha olefin is reacted with an SiH group. This meets the hydrosilylation reaction in step [A]. The resulting alkyl modified siloxane then undergoes a hydrogenation reaction in the presence of a hydrogenation catalyst, as taught in paragraph 5. This step deodorizes the resulting alkyl modified siloxane. This meets claimed step [B]. Such siloxanes can be used in cosmetics.

Thus one having ordinary skill in the art would have been motivated to use the method disclosed in JP 2003-306550 to prepare the alkyl modified siloxane in JP 2003-048813 in an effort to obtain a siloxane having reduced odor. In this manner the skilled artisan would have found the claimed process and resulting product obvious.

For claim 3, see paragraph 7.

6. The remaining patents are cited as being of general interest. 5,413,781, 4,640,792, 6,803,440 and 3,671,433 all teach different methods of preparing an alkyl modified siloxane. The Branlard et al. references teach hydrogenating the reaction product of an SiH and olefin but do not teach an alkene (olefin) reactant per se.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/
Primary Examiner, Art Unit
1796

mgm
6/16/10